

REMARKSI. Introduction

In a nonfinal Office Action mailed May 5, 2010, the Examiner rejected claims 37-38, 42, and 48-49 under 35 U.S.C. § 103(a) over a combination of U.S. Publication No. 2002-0002452 ("Christy") and U.S. Publication No. 2002-0188670 ("Stringham") and rejected claims 39-41 and 50-52 under 35 U.S.C. § 103(a) over a combination of over Christy, Stringham, and U.S. Publication No. 2001-0029455 ("Chin").

Applicant herein adds new claims 59-64. New claims 59-64 are identical to previously canceled claims 53-58, which were canceled in a response filed January 28, 2010. Accordingly, claims 37-42, 48-52, and 59-64 are now pending. For reasons discussed in detail below, applicant respectfully submits that the pending claims are in condition for allowance.

II. Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 37-42 and 48-52 under 35 U.S.C. § 103(a) over combinations of Christy, Stringham, and Chin. Applicant respectfully traverses these rejections and submits that the cited references, individually and in combination, fail to disclose or suggest all of the elements recited by the pending claims.

A. The cited references fail to disclose or suggest a first device that both sends and receives a translation preference during initiation of an instant messaging session

Independent claim 37 recites, during initiation of an instant messaging session between the first device and the second device, "sending by the first device to the second device an indication of the first translation preference" and "receiving by the first device from the second device an indication of the second translation preference" (emphasis added). Although the Examiner acknowledges that Christy does not disclose

the recited exchange of language preferences, the Examiner asserts that Stringham cures this deficiency (Office Action, p. 3). In particular, the Examiner asserts that:

Stringham requires the system to be knowledgeable of the recipient's language preference. The language preference is sent to the first device (sender's device) and thus it would be obvious for the second user to exchange the language preference prior to a message being sent (the same goes for the transaction with the second user receiving the first user's language preference).

(*id.* emphasis added). First, applicant submits that the Examiner does not identify where Stringham discloses a sender device that receives a language preference from a correspondent device. Second, applicant has thoroughly reviewed Stringham and nowhere does Stringham disclose or suggest a sender device that receives a language preference from a correspondent device, much less a sender device that both sends and receives a translation preference during initiation of an instant messaging session. Indeed, Stringham states that "the e-mail program accesses and searches the first database to find the location where information associated with the designated correspondent is stored and retrieves the name of the language used by the designated correspondent" (Stringham ¶ [0018]; emphasis added). Nowhere does Stringham disclose or suggest that the retrieved language used by the designated correspondent is received from the device of the designated correspondent. Indeed, Stringham indicates that such information is provided by the user of the e-mail program and stored in the database for later use (see, e.g., *id.* ¶ [0017]). Because Stringham's user who is to send an e-mail also provides the designated correspondent's language, Stringham has no need to receive the language from the designated correspondent's device during initiation of a session as recited by the pending claims.

For at least this reason, applicant submits that claim 37 and each of its dependent claims are patentable over the cited references. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 37-38 and 42 under 35 U.S.C. § 103(a) over the combination of Christy and Stringham,

and the rejection of claims 39-41 under 35 U.S.C. § 103(a) over the combination of over Christy, Stringham, and Chin.

Independent claim 48 recites “a component of [a] first device that, during the establishment of the instant messaging session, receives from [a] second device an indication of the second translation preference” (emphasis added). For reasons similar to those discussed above regarding claim 37, applicants submits that claim 48 and each of its dependent claims are patentable over the cited references. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 48-49 under 35 U.S.C. § 103(a) over the combination of Christy and Stringham, and the rejection of claims 50-52 under 35 U.S.C. § 103(a) over the combination of over Christy, Stringham, and Chin.

B. The cited references fail to disclose or suggest a first device that translates a message from a first translation preference to a second translation preference based on the received indication of the second translation preference

Claims 37-42 recite “based on the received indication of the second translation preference, translating by the first device the received first message from the first translation preference to the second translation preference.” Claims 48-52 recite “a component of the first device . . . that automatically translates the first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session.” Thus, the claims recite that the first device receives a translation preference from the second device and uses that received translation preference to translate messages before sending them to the second device.

Although the Examiner acknowledges that Christy does not disclose that the translation is done by the first device based on the received indication of the second translation preference (Office Action pp. 3-4), the Examiner asserts that Stringham cures this deficiency. In particular, the Examiner asserts that:

Stringham, in the same field of endeavor, teaches that language translation maybe performed at the sender's device (abstract). Stringham requires the system to be knowledgeable of the recipient's language preference. The language preference is sent to the first device (sender's device) and thus it would be obvious for the second user to exchange the language preference prior to a message being sent (the same goes for the transaction with the second user receiving the first user's language preference).

(*id.*) The Examiner's characterization of Stringham does not suggest, or identify where, Stringham discloses that the translation of a message is based on a language preference received from the device of the party (i.e., designated correspondent) to whom the translated message is to be sent, as recited. Moreover, nowhere does Stringham disclose or suggest that the language translation is performed based on such a received language preference. As discussed above in Section II(A), Stringham states that "the e-mail program accesses and searches the first database to find the location where information associated with the designated correspondent is stored and retrieves the name of the language used by the designated correspondent" (Stringham ¶ [0018]). Nowhere does Stringham disclose or suggest that the retrieved language used by the designated correspondent is received from the device of the designated correspondent. Indeed, Stringham indicates that such information is provided by the user of the e-mail program and stored in the database for later use (see, e.g., *id.* ¶ [0017]). Thus, applicant respectfully submits that Stringham does not disclose or suggest translating based on such a "received indication of the second translation preference," as recited. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 37-38, 42, and 48-49 under 35 U.S.C. § 103(a) over the combination of Christy and Stringham, and the rejection of claims 39-41 and 50-52 under 35 U.S.C. § 103(a) over the combination of over Christy, Stringham, and Chin.

C. There is no reason to combine Christy and Stringham, at least because the combination would change the principle operation of Christy

To establish a *prima facie* case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed

by the patent at issue" (*KSR Int'l Co.*, 127 S. Ct. at 1740-41). The Examiner's analysis "should be made explicit" (*id.*). That is, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*id.* citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

The Examiner asserts that one would be motivated to combine Christy and Stringham so that "the message recipient does not need to translate incoming messages or enlist the services of a person with language translation skills" (Office Action p. 4). Applicant disagrees with this assertion and submits that one skilled in the art would not combine Christy and Stringham to enable language translation to be performed by the user's device, as suggested by the Examiner, because the proposed combination would change the principal operation of Christy's translation servers 520₁ and 520₂. Christy makes clear that, prior to sending an e-mail message, the sender interacts with a translation server 520₁ to disambiguate the message and place it in conformity with the constrained grammar (Christy ¶¶ [0068], [0071]). Upon receiving the conforming message, the recipient sends the message to its translation server 520₂ to translate the conforming message into the recipient's chosen language (*id.*). If Christy were modified to perform translation at each user's device, then Christy's translation servers 520₁ and 520₂ would serve no purpose. Because the purpose of Christy's translation servers 520₁ and 520₂ are to translate users' messages, there would be no reason to modify Christy's system to enable language translation to be performed at a user's device. Thus, one skilled in the art would not modify Christy's system to enable language translation to be performed at the user's device, as suggested by the Examiner, because it would change the principal operation of Christy's translation servers 520₁ and 520₂.

Applicant further submits that one skilled in the art would not seek to combine Christy and Stringham, at least because one skilled in the art would have no reasonable expectation of success. That is, even if it were possible to combine Christy and Stringham without changing the principle operation of Christy, a technique for doing so would entail complexities that would require detailed explanation for one skilled in the art to implement, which is not present in either Christy or Stringham.

Moreover, Christy teaches away from performing translation at each user's device because doing so, according to Christy, would require "special software" (see, e.g., Christy ¶ [0061]: According to Christy, "the user will not require special software to use the invention...The user enters text, and, in translation applications, specifies a preferred language (step 200). The user submits the text to a language server, which, through back-and-forth communication with the user, creates an Input XML representation of the user's text (steps 205, 210)."'). Although Christy states that a user's e-mail client may be configured to facilitate constrained-grammar editing and disambiguation (*id*), nowhere does Christy disclose or suggest that the e-mail client can be configured to include specialized software to translate messages. Thus, one skilled in the art would not modify Christy's system to enable language translation to be performed at the user's device, as suggested by the Examiner, because Christy teaches away from such a modification.

For at least these reasons, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 37-38, 42, and 48-49 under 35 U.S.C. § 103(a) over the combination of Christy and Stringham, and the rejection of claims 39-41 and 50-52 under 35 U.S.C. § 103(a) over the combination of over Christy, Stringham, and Chin.

III. Conclusion

In view of the above remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a

telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned directly at (206) 359-6088.

Please charge any deficiencies or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 418268888US from which the undersigned is authorized to draw.

Dated: 7/15/10

Respectfully submitted,

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